

Appl. No. 09/991,880
Amendment dated September 14, 2004
Reply to Office Action of September 3, 2004

REMARKS

In the September 3, 2004 Office Action, the drawings were objected to and claims 1-8, 11-13, 16-19 and 22 stand rejected for lack of written description. Claims 9, 10, 15, 20 and 21 are allowed. No prior art rejections were made against the claims.

Status of Claims and Amendments

In response to the September 3, 2004 Office Action, Applicant has amended independent claims 1 and 2 and canceled claim 22 as indicated above. Applicant has also amended the specification to correct a clear error. Applicant wishes to thank the Examiner for the indication of allowable subject matter. Thus, claims 1-13 and 15-21 are pending, with claims 1, 2, 9 and 20 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

Drawings

In paragraph 1 of the Office Action, the drawings were objected to as failing to comply with 37 CFR §1.83(a) for three reasons. Applicant believes that the drawings comply with 37 CFR §1.83(a) in view of the amendments to the specification and drawings. Applicant believes that these drawings do not raise new matter or new issues.

In particular, the drawings were first objected to because the drawing failed to show

first and second rear surfaces of the mounting flanges [40 and 42] being spaced apart by a distance larger than a distance between front and rear planes [FP and RP] as claimed in claim 1.

However, as seen in Figures 4, 7, 8 and 11, the drawings clearly show this dimensional relationship of claim 1. The confusion appears to be based on a typographical error in the specification, which has been corrected in this Amendment. In particular, the paragraph beginning at page 11, line 23 erroneously stated that "curved mounting surface 45 of the mounting portion 44 preferably has a radius of curvature Y of about 34.9 millimeters". This

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dimension of 34.9 millimeters should have referred to the diameter. One skilled in the art would clearly recognize this error in that seat tube is normally about 34.9 millimeters in diameter.

In addition, it is well established in U.S. Patent law that an applicant can rely on drawings for support of dimensional relationships in the claims. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). In the *Vas-Cath Inc.* case, the court upheld the Examiner's statement that the claimed range for a ratio of dimensions was fully supported by the drawings taken from the parent, which was a design patent. The Federal Circuit made it clear that the drawings form part of the written description of a patent application.

Applicant respectfully requests withdrawal of this first drawing objection in view of the specification amendments and the revisions to Figure 4.

Second, the drawings were objected to because the drawing failed to show first and second rearward surfaces being spaced apart by a distance that is about one half of the maximum axial length of the chain guide as claimed in claim 2.

In response, claim 2 has been amended to cancel the objected to material. Thus, this objection to the drawing is now believed to be moot. Applicant respectfully requests withdrawal of this second drawing objection.

Third, the drawings were objected to because the drawing failed to show rear mounting flange of the chain guide being located at least partially rearwardly of a longitudinal center point of the chain guide as claimed in claim 20¹ (sic).

In response, claim 22 has been cancelled. Thus, this objection to the drawing is now moot. Applicant respectfully requests withdrawal of this third drawing objection.

¹ Applicant believes this objection refers to claim 22 instead of claim 20, since this limitation appears in claim 22.

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Claim Rejections - 35 U.S.C. §112

In paragraph 2 of the Office Action, claims 1-8, 11-13, 16-19 and 22 were rejected under 35 U.S.C. §112, first paragraph. More specifically, certain language of claims 1, 2 and 22 were rejected as failing to comply with the written description requirement.

Regarding claim 1, Applicant respectfully submits that claim 1 is fully supported by the disclosure, including the drawings. As stated above, as seen in Figures 4, 7, 8 and 11, the drawings clearly show this dimensional relationship of claim 1. The confusion appears to be based on a typographical error in the specification, which has been corrected in this Amendment. In particular, the paragraph beginning at page 11, line 23 erroneously stated that "curved mounting surface 45 of the mounting portion 44 preferably has a radius of curvature Y of about 34.9 millimeters". This dimension of 34.9 millimeters should have referred to the diameter. One skilled in the art would clearly recognize this error in that seat tube is normally about 34.9 millimeters in diameter.

Most importantly, Applicant can rely on the drawings for support of "first and second mounting flanges having first and second rear surfaces that are spaced apart by an axial distance larger than an axial space between said front and rear planes." In *Vas-Cath Inc. v. Mahurkar*, the patented claim recited a first dimension substantially greater than one-half but substantially less than a second dimension. The Examiner stated that the drawings, which were from a corresponding design patent, fully supported the claims. The Court of Appeals for the Federal Circuit upheld the Examiner's statement and found that the written description requirement was met by the drawings. Additionally, MPEP §2163.02, cites and discusses *Vas-Cath Inc. v. Mahurkar* for its explanation of the written description requirement. Accordingly, for the reasons above, independent claim 1 is fully supported and the written

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description requirement is met. Applicant believes that claim 1 complies with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested

Regarding the specific limitations presented in independent claim 2, Applicant has amended claim 2 to remove the objectionable limitations from the claim. Applicant believes that claim 2 now complies with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

Regarding the specific limitations presented in independent claim 22, Applicant has canceled claim 22. Thus, this rejection is now moot. Applicant respectfully requests withdrawal of this rejection.

Prior Art of Record

In previous Office Actions rejections were made against independent claims 1 and 2 in view of U.S. Patent No. 3,730,012 (Juy) as anticipating or rendering obvious claims 1 and 2 of the present application.

Applicant wishes to point out that Juy does not anticipate or render obvious claims 1-21. Specifically, independent claims 1 and 2 recite a second link pivotally coupled to the first *and* second mounting flanges. The link 4 of Juy is not coupled to both first and second mounting flanges. Rather, the link 4 of Juy is pivotally coupled to only one of the first and second mounting flanges. Therefore, Juy does not disclose or fairly suggest a second link pivotally coupled to the first *and* second mounting flanges.

The combination of Juy with other references such as U.S. Patent No. 6,099,425 (Kondo) does not remedy this deficiency. Extending the link 4 of Juy such that it could somehow be pivotally coupled to the first and second mounting flanges would destroy the teachings of the reference and render the device inoperable. More specifically, if the device of the Juy patent were somehow modified to meet the claims of the present invention, it

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would require a complete reconstruction of the derailleur of the Juy patent, which would destroy the teachings of the reference.

In further regards to Kondo, the reference does not disclose first and second mounting flanges having different axial widths. This deficiency cannot be remedied by combination with the Juy patent. The flange of Juy is utilized as a support for the linkage assembly *and* a mounting portion to mount the device to the bicycle frame. Even if Juy teaches a thicker width on one of the flanges for added strength, it is because the flange is the only structure holding the linkage assembly. In other words, two flanges are not used to support the linkage assembly. In addition to use as a support mechanism, the flange of Juy is also used to mount the entire device to the bicycle frame. In contrast, the flanges of Kondo do not pull double duty. That is, *both* flanges are used for connection to the linkage assembly only. One of ordinary skill in the art would not find reason to modify the width of either flange in Kondo since *both* flanges share in supporting the linkage assembly *and* do not functionally mount the entire device to the frame.

Therefore, Applicant respectfully submits that claims 1-21 are allowable over the prior art of record.

Allowable Subject Matter

In paragraph 4 of the Office Action, claims 9, 10, 15, 20 and 21 were indicated as allowed. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

Contact Applicant's Representative

The Examiner is invited to contact the undersigned if an Examiner's Amendment or discussion of the claims will help to further prosecution.

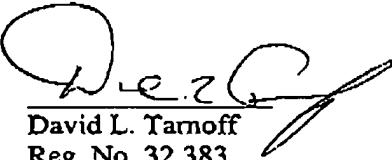
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Conclusion

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-13 and 15-21 are now in condition for allowance. Withdrawal of the final office action and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,



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